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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,285	06/01/2006	Tetsuro Iwanaga	1422-0718PUS1	3178
2292 7590 03/31/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER KARPINSKI, LUKE E				
ART UNIT 1616		PAPER NUMBER		
NOTIFICATION DATE 03/31/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/581,285

Applicant(s)

IWANAGA ET AL.

Examiner

LUKE E. KARPINSKI

Art Unit

1616

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Receipt of amendments, arguments, and remarks filed 12/23/2009 is acknowledged.

Claims

Claims 2, 4, and 5 are canceled.

Claim 6 is new.

Claims 1, 3, and 6 are pending and under consideration in this action.

Rejections

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the specification nor the claims as originally filed have support for a range from 15-50. Although the numbers 15 and 50 are recited, they are not recited together and 15 is only disclosed as a preferred upper limit, not as a lower limit.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1, 3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,466,719 to Jakobson et al. in view of JP-2001-025654 utilizing the enclosed translation, herein referred to as JP'654.

Applicant Claims

Applicant claims compositions comprising a fatty acid ester and a non-ionic surfactant wherein said ester is formed from a fatty acid having 6-10 carbon atoms and a polyglycerol having an average degree of polymerization of 15-50.

Applicant also claims an oil present at 10-99.8%, 0-80% water and said composition as a cleansing cosmetic.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

Jakobson et al. teach cleansing compositions (col. 10, lines 44-50) comprising polyglycerol fatty acid esters made through the reaction of polyglycerols having a degree of polymerization of 2-8 and fatty acids having 6-14 carbon atoms (abstract) and

oils showing a liquid or pasty state at 25 degrees (col. 6, lines 21-55) as pertaining to claim 1.

Jacobson et al. further teach 0-70% water (col. 5, line 13), as pertaining to claim 3, and said oils present at 10-60% (col. 5, lines 11-12), as pertaining to claim 6.

Ascertainment of the differences between the prior art and the claims
(MPEP 2141.01)

Jakobson et al. do not teach an average degree of polymerization from 15-50. This deficiency is cured by JP'654. JP'654 teaches cleansing compositions comprising a polyglycerol fatty acid ester with an average degree of polymerization of 2-16 [11].

Finding of prima facie Obviousness Rational and Motivation

Regarding claim 1, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of Jakobson et al. with polyglycerol fatty acid esters having an average degree of polymerization of 2-16 as taught by JP'654 in order to produce the invention of instant claim 1.

One of ordinary skill in the art would have been motivated to do this because Jakobson and JP'654 both teach cleansing compositions comprising polyglycerol fatty acid esters and teach overlapping ranges of degrees of polymerization. Therefore it would have been obvious to utilize the polyglycerol fatty acid esters of JP'654, in the formulations of Jakobson et al. in order to use polyglycerol fatty acid esters known to be useful in cleansing compositions.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

2. Claims 1, 3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-2003-012456 utilizing the enclosed translation, hereafter referred to as JP-456, in view of USPN 5,466,719 to Jakobson et al.

Applicant Claims

Applicant claims are delineated above and incorporated herein.

Determination of the Scope and Content of the Prior Art
(MPEP §2141.01)

JP-456 teaches cleansing creams [1] comprising polyglycerol fatty acid esters [4], comprising polyglycerin with a degree of polymerization of three or more and fatty acids having 8-22 carbon atoms [6], and oils showing a liquid or pasty state at 25 degrees [12], as pertaining to claim 1.

JP-456 further teaches water and oils emulsions, which reads on claims 3 and 6 [1].

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

JP-456 does not teach percentages of oil or water present. This deficiency is cured by Jakobson et al. Jakobson et al. teach cleansing formulations comprising 0-70% water and 10-60% oil (col. 5, lines 9-15), as pertaining to claims 3 and 6.

Finding of prima facie Obviousness Rational and Motivation

(MPEP 2142-2143)

Regarding claims 3 and 6, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of JP'456 with 10-60% oil and 0-70% water as taught by Jakobson et al. in order to produce the invention of instant claims 3 and 6.

One of ordinary skill in the art would have been motivated to do this because Jakobson and JP'456 both teach cleansing compositions comprising oil and water and Jakobson et al. teach specific percentages of said components to use. Therefore it would have been obvious to utilize the oil and water percentages of Jakobson et al. in the formulations of JP'456 in order to use produce cleansing compositions with known amounts of water and oil.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to

one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

3. Claims 1, 3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-2001-025654 utilizing the enclosed translation, herein referred to as JP'654.

Applicant Claims

Applicant claims are delineated above and incorporated herein.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

JP'654 teaches cleansing compositions comprising polyglycerol fatty acid esters [1], comprising fatty acids with 8-24 carbons [8], a degree of polymerization of 2-16 [11], and oils showing a liquid or pasty state at 25 degrees [13], as pertaining to claim 1.

JP'654 further teaches water and oil mixtures of 1-50% of said compositions, which reads on about 1-50% of water and about 1-50% oil [15], as pertaining to claims 3 and 6.

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

JP'654 does not explicitly disclose an example wherein the claimed

components, at the claimed percentages are combined into a single composition.

However, JP'654 does teach that each of the claimed components may be combined into the same cleansing composition.

Finding of prima facie Obviousness Rational and Motivation
(MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select each component and combine them as instantly claimed because JP'654 suggests that the instant components can be combined or mixed together. In a prior art reference it is not necessary for all of the possible compositions to be exemplified in order for the art to render an invention obvious.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

Claims 1, 3, and 6 are rejected.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **LUKE E. KARPINSKI** whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Friday 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Mina Haghighatian/
Primary Examiner, Art Unit 1616